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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,647	06/07/2000	Joe McCollum	23200 EH-001	8728

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,647

Applicant(s)

MCCOLLUM ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 7 June 2000. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-10, 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 in view of Edelson et al, U.S. Patent Number 5, 737, 539.

(A) As per claim 1, Eberhardt teaches a method of obtaining a patient record or document using an online location on an electronic medium (Eberhardt; Figure 1), comprising:
requesting an order, by a requestor, for the patient record or document from the online location (Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48).

Eberhardt fails to explicitly disclose:

providing to the requestor a cover letter or authorization having an identifier, the identifier having order information;

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sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order;

requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location; and

obtaining, by the requestor, the patient record or document from the destination location.

Edelson teaches:

providing to the requestor a cover letter or authorization having an identifier, the identifier having order information (Edelson; column 16, lines 10-24, column 17, lines 5-62);

sending, by the requestor, the cover letter along with a patient authorization letter or electronic release to a processing center, for completing the order (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63);

requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location (Edelson; Figure 3, Item 80, column 26, line 56 to column 27, line 5, column 31, lines 48-63, column 45, lines 55-64); and

obtaining, by the requestor, the patient record or document from the destination location (Edelson; column 10, lines 55-66, column 14, lines 19-24, 53-60, column 48, lines 10-20, column 50, lines 54-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of obtaining a patient record or document using an online location on an electronic medium of Eberhardt, to include providing to the requestor a cover letter or authorization having an identifier, the identifier having order information; sending, by

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the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order; requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location; and obtaining, by the requestor, the patient record or document from the destination location, as taught by Edelson, with the motivation of making integrated patient-specific information readily available to medical prescribing professionals, to utilize medical information which is widely distributed geographically, and to enable such access in the light of proprietary, liability and patient confidentiality concerns (Edelson; column 2, lines 8-15).

(B) Claim 2 differs from claim 1 in that it is a system for obtaining a patient record or document using an online location on an electronic medium rather than a method of obtaining a patient record or document using an online location on an electronic medium.

As per claim 2, Eberhardt and Edelson teach a system for obtaining a patient record or document using an online location on an electronic medium (Eberhardt; Figure 1), comprising:

means for requesting, by a requestor, an order for the patient record or document from the online location (Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48);

means for providing the requestor a cover letter having an identifier for identifying the order (Edelson; column 16, lines 10-24, column 17, lines 5-62);

means for sending, by the requestor, the cover letter along with a patient authorization letter to a processing center (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63);

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means for requesting the patient record or document from a shipping location (Edelson; Figure 3, Item 80, column 26, line 56 to column 27, line 5, column 31, lines 48-63, column 45, lines 55-64);

means for receiving, by a destination location, the patient record or document from the shipping location (Edelson; column 17, lines 37-39, column 34, lines 17-20, column 48, lines 14-20); and

means for obtaining the patient record or document from the destination location (Edelson; column 10, lines 55-66, column 14, lines 19-24, 53-60, column 48, lines 10-20, column 50, lines 54-60).

The motivations for combining the respective teachings of Eberhardt and Edelson are as given in the rejection of claim 1 above, and incorporated herein.

(C) As per claim 4, Eberhardt and Edelson teach a method described in claim 1 above, wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52).

(D) As per claims 5-6, Eberhardt and Edelson teach a method described in claim 1 above, further comprising inputting patient information in a graphical user interface window before requesting the order (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8), and wherein the patient information includes at least one of a claim number, first name, last name, social security number, and date of birth (Eberhardt; column 3, lines 55-68).

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(E) As per claim 7, Eberhardt and Edelson teach a method described in claim 1 above, wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28).

(F) As per claims 8-9, Eberhardt and Edelson teach a method described in claim 1 above, wherein sending the cover letter comprises faxing the cover letter to the processing center (Edelson; column 17, lines 52-55), and further comprising automatically reading and identifying, by the processing center, the identifier on the cover letter (Edelson; column 8, lines 39-44, column 51, lines 23-28).

(G) As per claim 10, Eberhardt and Edelson teach a system described in claim 2 above, wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52).

(H) As per claim 12, Eberhardt and Edelson teach a system described in claim 2 above, wherein the means for requesting the order comprises inputting patient information in a graphical user interface window (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8).

(I) As per claim 13, Eberhardt and Edelson teach a system described in claim 2 above, wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28).

(J) As per claims 14-15, Eberhardt and Edelson teach a system described in claim 2 above, wherein sending the cover letter comprises faxing the cover letter to the processing center

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(Edelson; column 17, lines 52-55) and wherein sending the cover letter comprises mailing the cover letter to the processing center (Edelson; Figure 1, Item 16, column 12, lines 5-13).

(K) Claim 16 differs from claims 1 and 2 in that it is a method of ordering, by a requestor, a patient record or document using an online location rather than a method of obtaining a patient record or document from an online location or a system for obtaining a patient record or document using an online location.

As per claim 16, Eberhardt and Edelson teach a method of ordering, by a requestor, a patient record or document using an online location, comprising:

requesting an order for the patient record or document from the online location
(Eberhardt; Figure 1, column 8, lines 31-34, column 9, lines 44-48);

providing to the requestor a cover letter having an identifier, the identifier having order information (Edelson; column 16, lines 10-24, column 17, lines 5-62); and
sending the cover letter along with a patient authorization letter to a processing center associated with the online location for completing the order (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63).

(L) As per claim 17, Eberhardt and Edelson teach a method described in claim 16 above, wherein the requestor comprises an insurance company (Eberhardt; column 8, lines 49-52).

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The motivations for combining the respective teachings of Eberhardt and Edelson are as given in the rejection of claim 1 above, and incorporated herein.

(M) As per claim 18, Eberhardt and Edelson teach a method described in claim 16 above, further comprising inputting patient information in a graphical user interface window before requesting the order (Eberhardt; column 6, lines 12-21, column 8, line 62 to column 9, line 8).

(N) As per claim 19, Eberhardt and Edelson teach a method described in claim 16 above, wherein the identifier comprises a bar code (Edelson; column 51, lines 23-28).

(O) As per claim 20, Eberhardt and Edelson teach a method described in claim 16 above, wherein sending the cover letter comprises faxing the cover letter to the processing center (Edelson; column 17, lines 52-55).

4. Claims 3, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 and Edelson et al, U.S. Patent Number 5, 737, 539, as applied to claims 1 and 2 above, and further in view of Coli et al, U.S. Patent Number 6, 018, 713.

(A) As per claims 3,11, Eberhardt and Edelson teach a system and method discussed above, in claims 1 and 2.

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Eberhardt and Edelson teach the online location comprising the Internet (Eberhardt; column 7, lines 21-24) (Edelson; column 47, lines 1-7), but fail to explicitly disclose a method wherein the online location comprises a web site.

Coli teaches a system and method wherein the online location comprises a web site (Coli; see at least column 8, lines 56-60, column 10, lines 15-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of obtaining a patient record or document using an online location on an electronic medium of Eberhardt and Edelson to include wherein the online location comprises a web site, as taught by Coli, with the motivation of providing integrated results reporting in a consistent and easy-to-understand manner within a system that provides effective communication of test orders, medical records and results between a physician's office and a remote user, allowing appropriate transmission of test orders and medical records, preferably over the Internet (Coli; column 2, lines 52-63).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Herz et al, U.S. Patent Number 5, 754, 939 and the 2 articles teach the environment of online medical record or document retrieval.

Herz et al, U.S. Patent Number 5, 754, 939, teaches a system for generation of user profiles and customized electronic document retrieval over the Internet.

Anonymous. InstantDocuments.com Contracts Mynd Corporation As Reseller. May 25, 2000. Business Wire; New York. [Retrieved on November 18, 2002]. Retrieved from ProQuest.

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Fischer, Karin. Rockefeller proposes Net privacy bill: Legislation would require user's OK to collect data. May 23, 2000. Charleston Daily Mail; Charleston. [Retrieved on November 18, 2002]. Retrieved from ProQuest.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(703) 305-7687.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP
Natalie A. Pass

November 18, 2002


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600